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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/786,204 | 03/02/2001 | John Henry Forster | P277103 | 6271 |

909 7590 10/17/2003
PILLSBURY WINTHROP, LLP
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MCLEAN, VA 22102

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| EXAMINER |
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SAWHNEY, HARGOBIND S

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| ART UNIT | PAPER NUMBER |
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2875

DATE MAILED: 10/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/786,204

Applicant(s)

FORSTER ET AL.

Examiner

Hargobind S Sawhney

Art Unit

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-- Th MAILING DATE of this communication app ars on the cov r sheet with th correspond nce address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The amendment filed on July 30, 2003 has been entered. Accordingly, Claim 9 has been cancelled and Claim 1 has been amended.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klick et al. (European Patent Publication No. 0660293 A3).

The English translation of Klick et al. (European Patent Publication No. 0660293 A3) submitted by the applicant does not have page numbers. Therefore, the examiner has assigned page numbers to facilitate the examination. Marked-up copy is attached with this Office Action.

Regarding claims 1,2 and 11, Klick et al. (European Patent Publication No. 0660293 A3) disclose an edge-lit illumination system (Figure 9) comprising:

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- a light transmitting sheet 1 (English translation, Figure 9, page 7, Para. 10) and a light source positioned in proximity to and adjacent to an edge of the light transmitting sheet 1 (English translation, Figures 2 and 9, page 7, Para. 10);
- at least one - the limitation " at least one" being interpreted as either one or both opposing surfaces - of the two opposing surfaces of the light transmitting sheet 1 carrying markings (English translation, Figures 2 and 9); and
- the marking being randomly disposed on at least one nominal area of the at least one the opposing surfaces (English translation, Figures 2 and 9, page 7, Para. 10) .
- the markings being of irregular shapes, and being disposed randomly (English translation, Figure 1, page 4, lines 18 and 19) with in each of the nominal surface area.

However, regarding Claim 1, Klick et al. (European Patent Publication No. 0660293 A3) does not teach the specific range 0.1 to 10 mm covering the sizes of the randomly disposed markings on the transmitting sheet.

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the edge-lit illumination system of Klick by providing a light emitting sheet having marking of the sizes within the range 0.1 to 10 mm, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

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Regarding claims 3-10, Klick et al. (European Patent Publication No. 0660293 A3) does not teach an edge-lit illumination system comprising light emitting sheet including:

- the marking covering from (a) 0.1 to 99%; and (b) 1 to 40% of the sheet area;
- the light emitting sheet having each nominal area being of equal size;
the light-emitting sheet having each nominal area is of different size;
- the area of marking coverage in each nominal area being the same;
- the area of marking coverage being different in each nominal area; and
- marking ranges from 0.3 to 3 mm in length, and being of an irregular shape.

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the edge-lit illumination system of Klick by providing a light emitting sheet having specific size marking covering a specific nominal area, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

4. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Klick et al. (European Patent Publication No. 0660293 A3) in view of Murase et al. (US Patent 5,178,447)

Regarding claim 12, Klick et al. (European Patent Publication No. 0660293 A3) does not teach an edge-lit illumination system comprising a light-emitting sheet having

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its surface screen printed with markings. Instead, Klick et al. ('293 A3) teaches the light-emitting sheet covered with at least one layer having markings on its surface.

On the other hand, Murase et al. (US Patent 5,178,447) discloses an edge light panel 10 (Figures 1-3, column 3, line 55) having its surface screen-printed with markings (Figures 1-3, column 3, lines 55-58).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the edge-lit illumination system of Klick by providing a light emitting sheet with its surface screen printed with markings as taught by Murase et al. (US Patent 5,178,447) for benefit and advantage of cost saving resulting from not requiring an additional film printed with markings.

Response to Amendment

5. Applicant's arguments filed on July 30, 2003 with respect to the rejection under 35 U.S.C. 103(a) of Claim 3-10 have been fully considered but they are not persuasive.

Argument: Klick et al. (European Patent Publication No. 0660293 A3) teaches the random distribution of the markings not perceivable with the naked eyes. Thus, from the above- indicated Klick's teaching one could conclude that the sizes of the marking do not fall within 0.1 to 10 mm range. Therefore, Klick et al. (European Patent Publication

No. 0660293 A3) does not meet the limitation respective to the 0.1 to 10 mm range.

Response: Specific range 0.1 to 10 mm covering the sizes of the randomly disposed markings on the transmitting sheet has been recognized as a result-effective variable that could be characterized as routine experimentation. Thus, discovering an optimum value of a result effective variable involves only routine skill in the art.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hargobind S Sawhney whose telephone number is 703-306-5909. The examiner can normally be reached on 6:15 - 2:45.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on 703-305-4939. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2956.

HSS
October 11, 2003



Sandra O'Shea
Supervisory Patent Examiner
Technology Center 2800